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EXAMINER

TRAN, LOUIS B

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 09/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,890

Applicant(s)

LAGODZINSKI ET AL.

Examiner

Louis B Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to applicant's amendment, Paper No. 29, received on 07/14/2003. Applicant's cancellation of claims 3,4, 9, 10, 19, and 20 in Paper No. 29 is acknowledged.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5-8, 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melocco (5,90,894) in view of Wedell (5,065,988).

With respect to claim 1, Melocco shows the invention as claimed including a power actuated piston tool with a piston automatic return comprising an external barrel 1 having a rear end, a guiding barrel 7 disposed in the external barrel, a fastener guide 6 disposed in the external barrel 1, a piston means having a piston shank and a piston head disposed in said guiding barrel, said piston means 21 being configured to be moveable between a firing position, an initial position, and a fastening position, a firing pin assembly disposed at the rear end of the external barrel and operatively connected to the external barrel 1, and piston return means 11 configured to automatically return the piston means from the fastening position to the firing position, said piston return means being disposed on said piston shank between the piston head 9 and the fastener guide 6, said piston return means comprising a one piece elastic returning bush having

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a shape of bellows, said returning bush having an external bellows diameter which varies regularly in a longitudinal direction and an internal bellows diameter which varies regularly in the longitudinal direction, said piston return means being configured such that in the initial position, a sum of a longitudinal length of said piston return means plus a longitudinal length of the fastener guide is greater than a longitudinal length of the piston shank, returning bush having at least one end segment comprising ~~two~~^{two} narrowings and one swelling, (as in claim 1), wherein said returning bush is configured to approximate at least one of a stack of truncated-spherical segments, a stack of frusto-conical segments, and a stack of barrel shaped segments as seen in Figure 2 (as in claim 2), wherein a length of said returning bush is configured such that, in the initial position, a piston shank end face does not reach its extreme forward position and remains at a distance from a base as in column 4, lines 18-22 (as in claim 6), wherein a maximum external diameter of said returning bush is configured to be smaller than an internal diameter of the guiding barrel such that, in the initial position, an external diameter of said returning bush is smaller than the internal diameter of the guiding barrel seen in Figure 2 (as in claim 7), but does not explicitly show the maximum internal diameter of said at least one end segment being less than the maximum internal diameter of non-end segments of said returning bush, said at least one end segment having a maximum wall thickness which is greater than maximum wall thicknesses of the non-end segments.

However, Wedell teaches the use of a returning bush having at least one end segment comprising two narrowings and one swelling, the maximum internal diameter

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of said at least one end segment being less than the maximum internal diameter of non-end segments of said returning bush, said at least one end segment having a maximum wall thickness which is greater than maximum wall thicknesses of the non-end segments (as in claim 1), teaches the common spring design wherein at least one of the two end segments of the returning bush has an internal end surface that is curved such that a position of a center of curvature of the curved end surface is disposed at a distance from an end-face of said piston return means (as in claim 5), for the purpose of creating a more balanced spring as in column 1, lines 60-68.

Therefore, it would have been obvious to one having ordinary skill in the art to provide a spring with thickened end segments to provide stability in the spring.

With respect to claim 8, Melocco teaches an outer barrel having a firing chamber with an outer surface and a thick part disposed in the guiding barrel, said fastener guide being configured such that said thin end protrudes from the outer barrel, a piston having a piston head disposed in the guiding barrel and a piston shank disposed in the fastener guide, said piston being configured to be moveable from a firing position to an initial blocking position and to a fastening position, a firing pin assembly mounted at the first end of the outer barrel and a hollow element having a bellows shape configured to cause an automatic return of the piston from the fastening position to the firing position said hollow element being disposed on the piston shank between the piston head and the fastener guide, said hollow element comprising an elastomeric material, an external diameter of the hollow element and an internal diameter of the hollow element both varying regularly to form uniformly spaced dwellings and narrowings running

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longitudinally on an outer surface and an inner surface of the hollow element, wherein between each two neighboring narrowings is formed a segment with at least one of a sinusoidal, a frusta-spherical, a frusta-conical, and a barrel wall contour, and wherein in the initial blocking position a sum of a longitudinal length of said hollow element plus a longitudinal length of the fastener guide is greater than a length of the piston shank seen in Figure 2 said hollow element having at least one end segment comprising two narrowings, and one swelling (as in claim 8), wherein a sum of a longitudinal length of said hollow element plus a length of the fastener guide is greater than a length of the piston shank, said piston being configured such that a piston shank end face is distanced from the outer surface of the fastener guide in an initial blocking position of the piston as seen in Figure 2 (as in claim 12), but does not explicitly show the maximum internal diameter of said at least one end segment being less than the maximum internal diameter of non-end segments of said hollow element, said at least one end segment having a maximum wall thickness which is greater than maximum wall thicknesses of the non-end segments.

However, Wedell teaches the use of the maximum internal diameter of said at least one end segment being less than the maximum internal diameter of non-end segments of said hollow element, said at least one end segment having a maximum wall thickness which is greater than maximum wall thicknesses of the non-end segments (as in claim 8), wherein an inner end surface of end segments of said hollow element is outwardly curved (as in claim 11) for the purpose of creating a more balanced spring as in column 1, lines 60-68.

Therefore, it would have been obvious to one having ordinary skill in the art to provide a spring with thickened end segments to provide stability in the spring.

With respect to claim 13, Melocco teaches an outer barrel having a firing chamber at a first end thereof, a guiding barrel mounted in the outer barrel, a fastener guide having a thin end with an outer surface and a thick part disposed in the guiding barrel, said fastener guide being configured such that said thin end protrudes from the outer barrel, a piston having a piston head disposed in the guiding barrel and a piston shank disposed in the fastener guide, said piston being configured to be moveable between a firing position and a fastening position, a firing pin assembly mounted at the first end of the outer barrel, and a one piece hollow element formed of segments and disposed on the piston shank between the piston head and the fastener guide, said hollow element comprising elastomeric material, wherein a sum of a length of the fastener guide plus a length of said hollow element when the piston is in an initial blocking position is greater than a length of the piston shank, said piston being configured such that a piston shank end face is distanced from the outer surface of the fastener guide in the initial blocking position of the piston, said hollow element having at least one end segment comprising two narrowings and one swelling (as in claim 13), wherein a wall of each segment of the segments of the hollow element has a sinusoidal cross-section as seen in Figure 2 (as in claim 14), wherein a wall of each segment of the segments of the hollow element has a frustum of sphere cross-section as seen in Figure 2 (as in claim 15), wherein a wall of each segment of the segments of the hollow element has a frustum of a cone cross-section as seen in Figure 2 (as in claim 16),

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wherein a wall of each segment of the segments of the hollow element has a barrel cross-section as seen in Figure 2 (as in claim 17), wherein a wall of each segment of the segments of the hollow element has a frustum of barrel cross-section as seen in Figure 2 (as in claim 18), but does not show the maximum internal diameter of said at least one end segment being less than the maximum internal diameter of non-end segments of said hollow element, said at least one end segment having a maximum wall thickness which is greater than maximum wall thicknesses of the non-end segments.

However, Wedell teaches the maximum internal diameter of said at least one end segment being less than the maximum internal diameter of non-end segments of said hollow element, said at least one end segment having a maximum wall thickness which is greater than maximum wall thicknesses of the non-end segments seen in Figures 2 and 3 (as in claim 13) for the purpose of creating a more balanced spring as in column 1, lines 60-68

Therefore, it would have been obvious to one having ordinary skill in the art to provide a spring with thickened end segments to provide stability in the spring.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are Veglia, Kerr, Jarret et al., Planta, and Antkowiak, Knittel, Scowen.

Applicant's remarks have been fully considered but deemed moot in view of the new grounds of rejection.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For the reasons above, the grounds of rejection are deemed proper.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis B Tran whose telephone number is 703-305-0611. The examiner can normally be reached on 8AM-6PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

lbt



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700